

ESTTA Tracking number: **ESTTA440963**

Filing date: **11/14/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92054551
Party	Defendant Douglas Burda
Correspondence Address	DOUGLAS BURDA KONCEPT LLC 900 LAS VEGAS BOULEVARD SOUTH, UNIT 1009 LAS VEGAS, NV 89101 UNITED STATES dbb@konceptlaw.com
Submission	Motion to Amend/Amended Answer or Counterclaim
Filer's Name	Douglas Burda
Filer's e-mail	dbb@konceptlaw.com
Signature	/Douglas Burda/
Date	11/14/2011
Attachments	Amended Answer.pdf (9 pages)(281987 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

ANDREY PINSKY

Petitioner,

v.

Cancellation No. 92054551

DOUGLAS BURDA

Respondent.

**FIRST AMENDED ANSWER AND AFFIRMATIVE DEFENSES TO
PETITION FOR CANCELLATION**

Respondent, Douglas Burda (Registrant), an individual having an address of 900 Las Vegas Boulevard South, Unit 1009 in Las Vegas, Nevada 89101, believing it is rightfully and lawfully entitled to the continued use of the trademark delineated in United States Trademark Registration No. 3981394 on the Principal Register, hereby responds to Andrey Pinsky's (Petitioner's) Petition For Cancellation (Petition) as follows:

Any paragraph of the Petition stating a conclusion of law does not require Registrant's response, but to the extent that such a response is required, it is provided below.

The unnumbered paragraphs before numbered paragraph 1 in the Petition do not call for a response. Notwithstanding the foregoing, Registrant is without knowledge or information sufficient to form a belief as to the truth of the averment that Petitioner is, in fact, a Canadian lawyer.

1. Registrant denies the allegations of this averment.

2. Registrant admits that Registrant is an attorney licensed to practice in the State of Nevada in the United States, and that Registrant is the owner of United States Trademark Registration No. 3981394. Registrant denies the remaining allegations of this averment.
3. Registrant admits the allegations of this averment.
4. Registrant admits that Congress may regulate the sale, advertising, and promotion of legal services. Registrant denies the remaining allegations of this averment.
5. Registrant denies the allegations of this averment.
6. Registrant denies the allegations of this averment.
7. Registrant admits that Registrant uses and has obtained a federal registration for Registrant's mark (the Mark) (See the issued Certificate of Registration of the Mark, and a current printout of information from the Office's electronic database records showing the current status and title of the registration for same, attached hereto as Exhibit 1). Registrant denies the remaining allegations of this averment.
8. Registrant admits that Registrant uses and has obtained a federal registration for the Mark (See Exhibit 1). Registrant denies the remaining allegations of this averment.
9. Registrant admits that Registrant is engaged in the offering of legal services. Registrant denies the remaining allegations of this averment.
10. Registrant denies the allegations of this averment.
11. Registrant admits that Registrant uses and has obtained a federal registration for the Mark (See Exhibit 1). Registrant denies the remaining allegations of this averment.

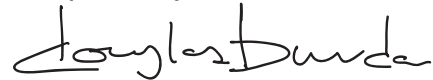
AFFIRMATIVE DEFENSES

Without waiver of its Answer, Registrant asserts the following affirmative defenses to the Petition:

- 12.** Petitioner fails to state a cognizable basis upon which relief can be granted as Petitioner's alleged use of Petitioner's alleged mark, even if proven, could not establish that Petitioner has or ever had superior rights to that of Registrant's.
- 13.** Petitioner has knowingly and with intent to deceive made misrepresentations to Registrant, to the public, and before the United States Patent and Trademark Office (USPTO), which were relied upon by each respective recipient of such misrepresentations to their respective detriments, and such misrepresentations warrant denial of the Petition.
- 14.** Petitioner lacks standing to practice before the United States Patent and Trademark Office in this matter because Petitioner, as an alleged Canadian attorney, has failed to provide information sufficient to establish that Petitioner may practice before the Office. Such circumstances warrant denial of the Petition.
- 15.** Petitioner has unclean hands that warrant denial of the Petition.
- 16.** Petitioner's claims are barred by the doctrine of laches.
- 17.** Petitioner's claims are barred because there is no likelihood of confusion.
- 18.** Registrant is at least entitled to registration with a restriction that Registrant is not using the Mark for provision of newsletters in the field of Canadian legal news. Such restriction will avoid any likelihood of confusion as Registrant is not using the Mark for provision of such services.

November 14, 2011

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Douglas Burda". The signature is fluid and cursive, with the first name "Douglas" written in a larger, more prominent script than the last name "Burda".

Douglas Burda

KONCEPT® LLC

900 Las Vegas Boulevard South

Unit 1009

Las Vegas, Nevada 89101

Phone. (248) 217-0002

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Attorney & Registrant

EXHIBIT 1

United States of America
United States Patent and Trademark Office

KONCEPT

Reg. No. 3,981,394

Registered June 21, 2011

Int. Cl.: 45

SERVICE MARK

PRINCIPAL REGISTER

BURDA, DOUGLAS (UNITED STATES INDIVIDUAL)
P.O. BOX 15533
LAS VEGAS, NV 89114

FOR: LEGAL SERVICES, IN CLASS 45 (U.S. CLS. 100 AND 101).

FIRST USE 6-12-2010; IN COMMERCE 6-12-2010.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 85-176,628, FILED 11-15-2010.

CARYN GLASSER, EXAMINING ATTORNEY



David J. Kypos

Director of the United States Patent and Trademark Office

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This page was generated by the TARR system on 2011-11-14 14:55:55 ET

Serial Number: 85176628 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 3981394

Mark

KONCEPT

(words only): [KONCEPT](#)

Standard Character claim: [Yes](#)

Current Status: A cancellation proceeding is pending at the Trademark Trial and Appeal Board. For further information, see TTABVue on the Trademark Trial and Appeal Board web page.

Date of Status: 2011-09-23

Filing Date: 2010-11-15

Filed as TEAS Plus Application: [Yes](#)

Currently TEAS Plus Application: [Yes](#)

Transformed into a National Application: [No](#)

Registration Date: 2011-06-21

Register: [Principal](#)

Law Office Assigned: [LAW OFFICE 108](#)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 650 -Publication And Issue Section

Date In Location: 2011-06-21

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. [Burda, Douglas](#)

Address:

[Burda, Douglas](#)
[900 Las Vegas Boulevard South, Unit 1009](#)
[Las Vegas, NV 89101](#)
[United States](#)

Legal Entity Type: [Individual](#)

Country of Citizenship: [United States](#)

Phone Number: [\(248\) 217-0002](#)

GOODS AND/OR SERVICES

International Class: [045](#)

Class Status: [Active](#)

[Legal services](#)

Basis: [1\(a\)](#)

First Use Date: [2010-06-12](#)

First Use in Commerce Date: [2010-06-12](#)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

[2011-09-25 - TEAS Change Of Correspondence Received](#)

[2011-09-23 - Cancellation Instituted No. 999999](#)

[2011-09-22 - Applicant/Correspondence Changes \(Non-Responsive\) Entered](#)

[2011-09-22 - TEAS Change Of Owner Address Received](#)

2011-06-21 - Registered - Principal Register
2011-06-16 - FAX RECEIVED
2011-04-05 - Notice Of Actual Publication E-Mailed
2011-04-05 - Published for opposition
2011-02-24 - Approved for Pub - Principal Register (Initial exam)
2011-02-24 - Assigned To Examiner
2010-11-19 - Notice Of Pseudo Mark Mailed
2010-11-18 - New Application Office Supplied Data Entered In Tram
2010-11-18 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Douglas Burda

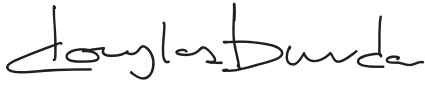
Correspondent

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KONCEPT LLC
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Phone Number: (248) 217-0002

CERTIFICATE OF ELECTRONIC FILING

I certify that a true and complete copy of the foregoing FIRST AMENDED ANSWER AND AFFIRMATIVE DEFENSES TO PETITION FOR CANCELLATION is being electronically transmitted to:

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office

By: 
Douglas Burda

CERTIFICATE OF SERVICE

I certify that a true and complete copy of the foregoing FIRST AMENDED ANSWER AND AFFIRMATIVE DEFENSES TO PETITION FOR CANCELLATION has been served on Andrey Pinsky by mailing said copy on November 14, 2011, via First Class Mail International, postage prepaid to:

ANDREY PINSKY
PINSKY LAW
45 SHEPPARD AVE EAST SUITE 900
TORONTO, ON M2N 5W9
CANADA

By: 
Douglas Burda